

PATENT
ATTY DOC. NO. 13819.71

REMARKS

This amendment is in response to the office action mailed February 24, 2005 for the above-identified patent application.

Double Patenting

On march 9, 2005 applicant filed by fax a request for clarification of the nonstatutory double patenting rejection under the judicially created doctrine of obviousness-type double patenting in the Office action mailed 02/24/2005, which stated:

“ In this rejection, the Examiner cites claims of U.S. patent number 6,547,120 ‘in view of Popovich et al’ It is not clear to Applicant, to what document the Examiner is referring as ‘Popovich et al.’ Nor does the Examiner mention ‘Popovich et al’ in the remainder of the statement of rejection. It is noted that at least two references of record appear as ‘Popovich et al’, namely, U.S. patent number 6,059,162 and European patent 1,197,301.

“In addition, the Examiner cites in the statement of rejection claims 1-3, 5, 11-14 and 17-18 of U.S. patent number 6,547,120. However, the statement of the grounds of rejection which follow refer only to claim 1 of this patent.

“It is respectfully requested that the Examiner clarify a) what document is being referred to as "Popovich et al." ; b) in what manner this document is being applied in the double patenting rejection, and c) in what manner claims 3, 5, 11-14 and 17-18 of US patent number 6,547,120 are being applied in the double patenting rejection.

“It is further requested that the Examiner issue a new office action clarifying the foregoing, and starting a new period for response.”

The undersigned has no record of receiving a reply to this Request.

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Accordingly, it will be assumed for purposes of this response that the "Popovich et al." referred to in the rejection is US patent 6,059,162. Applicant hereby respectfully traverses this rejection.

As the Examiner recognizes, the double patenting rejection requires a comparison of the claims of the application with the claims of the issued patent. The claims of US patent 6,547,120, as the Examiner recognizes, are not directed to the same invention as the claims of this application. For example, claim 1 of the issued patent, calls for a firing mechanism having a sleeve, and an indexing lever having a magazine strip engagement portion, which is in a first position when the sleeve is in a first position and which engagement portion is in a second position when the sleeve is in the second position.

This is in clear contrast to claim 1 in this application, wherein the strip engagement portion is operatively coupled to the trigger. It is submitted that the trigger and sleeve are not equivalent, and the examiner apparently recognizes this by citing Popovich et al. (US patent 6,059,162) as evidence that it would have been obvious to one having ordinary skill in the art to provide "a powder driven fastening tool having a firing mechanism which includes the trigger element for the purpose of actuating the firing mechanism."

However, there is no obvious way in which one of ordinary skill in the art would be led to substitute a trigger for the sleeve of the issued patent, because this would result in a nonfunctional tool, without further extensive reconfiguration thereof. Moreover, the Popovich '162 patent is directed to entirely different subject matter, namely, the provision of an exhaust baffle for a powder driven tool. Nor is there any obvious way in which the features of the issued patent could be added to the Popovich et al. reference, without extensive reconstruction thereof, since it does not disclose any of the features of claim 1 of this application or of claim 1 of the patent. Such reconstruction and reconfiguration would not be obvious to one of ordinary skill in the art.

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In the double patenting rejection, the examiner has specifically referred only to claim 1 of the application and to claim 1 of the patent. Accordingly, is not clear whether the examiner finds double patenting with respect to any of the others in claims 2 through 14, or on what basis. However, it is submitted that claims 2 through 14 add further details to claim 1 which are not coextensive with the claims in the issued patent.

Moreover, while the issued patent has an indexing lever, it really does not have any "link" as called for in claim 15, but rather, a "lever cam", which is a different mechanism and functions differently from the link, which is claimed as being coupled to the trigger, which trigger the issued patent lacks.

Accordingly, is believed that the double patenting rejection is not sustainable and should be deemed overcome by the above response.

35 U.S.C. 112

The above amendments to claims 6 and 14 are believed to overcome the rejections based on 35 U.S.C. 112. In particular, the above amendment changes the word "sleeve" in claim 6 to the correct term "strip engagement portion ". The above amendment deletes the words "to provide for fine tuning" in claim 14.

35 U.S.C. 102 and 103

With respect to the Examiner's rejections under 35 USC 102 and 103 based on US patent 4,375,269 to Bosch et al., in view of US patent 6,272,782 to Dittrich et al, it is believed that the above amendments clarify the patentable features of applicants' intervention which distinguish over these references.

The patent to Dittrich et al. has apparently been cited only for its teaching of a pawl and its relationship with a spring which is deflected during disengagement of the pawl of a notch. Accordingly, this reference adds nothing to supply the shortcomings of Bosch et al. noted above.

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The claims as amended above, and particularly new claim 15 now more clearly distinguish over anything taught by the Bosch et al. patent. Claim 15 clearly calls for the lever to have a first end cammingly engaged with the advancing link, an opposite end portion having a strip engagement portion extending into the channel for indexing the strip, and being pivotally coupled to the tool between these two end portions. In contrast, the Bosch et al. patent teaches a different mechanism wherein the "rigid link 47" is rotatably pinned to an extension 49 of the trigger 13, and is connected at its other end to a first link 41. The link 47 connects to the link 41 at a mid portion thereof with one end of link 41 being pivotally and slidably mounted to a slot 45 and the other end being movable relative to the magazine 15. Accordingly, new claim 15 is patentable over the rejections of record.

Claim 1 has been canceled in view of the submission of new claim 15, and the remaining claims 2 through 14 have been amended accordingly. Claim 4, clarifies that the pivotal coupling of the advancing lever to the tool is by a pivot pin, such that the strip engagement portion is disposed on one side of the pivot pin and the advancing lever is cammingly engaged with the advancing link on the other side of the pivot pin, as shown for example, in applicant's Figures 8 and 9. This is clearly a different arrangement from what is shown in Bosch et al., wherein, as noted above the mid portion of the link 41 is connected to link 47, not to the tool.

Claims 8 and 9 call for the engagement of the pawl with notches of the cartridge strip. Here, the Examiner has referred to the "hook member 55" of Bosch et al. However, it is clear that the hook member 55 is taught as being adapted to abuttingly engage a projecting portion of a cartridge 19, and has no engagement whatever with the cartridge strip as clearly called for in claims 8 and 9.

Similarly, claims 10 and 11 depend from claims 9 and 8, respectively, and further call for the movement of the pawl into engagement with a notch of the cartridge strip, when the trigger has been depressed sufficiently (claim 10) and for the bias spring (claim 11) for biasing the pawl into engagement with the notch, neither of which is taught or

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suggested by the Bosch et al. patent.


The Examiner has further cited the Dittrich et al. patent with respect to claims 11 and 12. However, Dittrich adds nothing to Bosch et al. which suggests the subject matter of these claims. Rather, it would appear inconsistent to assert first, that the part 55 is a pawl in Bosch et al., and then, that a spring 24 biasing a pawl 12 of Dittrich would somehow be obvious to combine with the Bosch et al. invention. In fact, since Bosch et al. includes no pawl at all, it would not appear to be obvious to one of ordinary skill in the art to add a spring and pawl, as Bosch et al. does not even teach or require engagement of a pawl with the cartridge strip.

Finally, with respect to claim 14, there is no teaching in the cited references of an adjustable connection between the trigger and the advance link. The trigger extension 49 of Bosch, referred to by the Examiner is clearly not in any way adjustable.

A consideration of these rejections, this is requested.

Dated this 24 day of May, 2005.

Respectfully submitted,



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